

### REMARKS

Claims 1-3, 5-6, 8, 14, and 16-26 are all the claims pending in the application. Claims 1-3, 5, 6, 8, and 14 stand rejected on prior art grounds. Claims 4, 7, 9-13, and 15 have been cancelled without prejudice or disclaimer. Claim 7 stands objected to only as being dependent upon a rejected base claim, and would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. The limitations of claim 7 have been added to claim 5 to place it in condition for immediate allowance. As such, claim 7 has been cancelled without prejudice or disclaimer. Claims 1, 5, and 14 are amended herein. Claims 16-26 are added herein. No new matter is being added. Applicants respectfully traverse the rejections based on the following discussion.

#### I. The Prior Art Rejections

Claims 1-3 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by Palalau (U.S. Patent 6,049,324). Claims 1-3 and 14 also stand rejected under 35 U.S.C. §102(b) as being anticipated by Toffolo et al. (U.S. Patent No. 6,337,675) hereinafter referred to as "Toffolo". Claims 5-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hyatt (U.S. Patent No. 4,121,284) in view of Arakawa (U.S. Patent No. 6,268,843). Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hyatt in view of Arakawa and Friend et al. (U.S. Patent No. 6,052,279) hereinafter referred to as "Friend". Applicants respectfully traverse these rejections based on the following discussion.

Palalau teaches a display system including a decoder receiving frames each including a brightness code for each pixel. The decoder generates a plurality of refresh commands for each

pixel in the frame based upon the brightness codes and stores each of the refresh commands in a different memory buffer. A driver reads the memory buffers sequentially at a refresh rate and drives the display based upon the refresh commands in each memory buffer.

Toffolo teaches a display system, which provides automatic and manual brightness control. A brightness controller varies the luminance of the display based upon ambient light as sensed by an ambient light sensor. The brightness control varies the luminance of the display between the minimum luminance at a minimum illuminance to a maximum luminance at a maximum illuminance. Preferably, a user input device selectively varies the maximum illuminance at which the display displays said maximum luminance and selectively alters the minimum luminance which is displayed at the minimum illuminance.

Hyatt teaches a system for operator interaction having a computer for enhanced operation. The computer performs switch debounce operations under program control and performs display refresh operations under program control. The computer is a fully integrated circuit computer in a preferred embodiment having an integrated circuit read only memory for storing a program and an integrated circuit scratchpad memory for storing operands.

Arakawa teaches an image display apparatus including an active display device, which is divided into picture elements, and a passive display device, which is divided into picture elements and which is superposed upon the active display device. The image display apparatus has a high luminance resolution and a high definition.

Friend teaches a customizable hand-held data terminal system employing multiple housing bases able to accommodate different components allow the manufacture of hand-held data terminals with a variety of features based on a single design. Because the system according to the present invention does not require the external mounting of components, the ergonomics

and basic footprint of the unit remains unaltered. The system also alleviates problems with moisture resistance, shielding, and survivability under harsh treatment associated with terminals employing externally mounted end cap modules or pod. Friend employs a plurality of different sized base units which can accommodate a variety of different components and configurations, and wherein the different base units are interchangeable with a single upper surface and user interface comprising a display screen and keypad.

However, as amended independent claims 1, 5, and 14 contain features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1, and 14 recite, in part, "...wherein the brightness of said display screen is set to a plurality of levels and the refresh rate of said display screen is set to correspond to each level of the brightness of said display screen." Similarly, claim 5 recites, in part, "...wherein the luminance of said light source is set to a plurality of levels and the refresh rate of said display panel is set to correspond to each level of the luminance of said light source."

The Office Action indicates on page 6 that the limitations of claim 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As such, the limitations of claim 7 are included in amended claim 5, which is the base claim, thereby making claim 5 allowable. As such, claim 7 is cancelled to avoid duplicity. Thus, in essence, the Office Action admits that the prior art of record fails to teach that the luminance of the light source is set to a plurality of levels and the refresh rate of the display panel is set to correspond to each level of the luminance of the light source. As such, amended independent claims 1 and 14 include similar language. Therefore, it follows that as amended, claims 1 and 14 are patentably distinct over the cited prior art of record, and are thus allowable.

In fact, these features are simply not taught or suggested in the prior art references of record. Namely, neither Palalau nor Toffolo say anything about the brightness of the display screen being set to a plurality of levels and the refresh rate of the display screen being set to correspond to each level of the brightness of the display screen. Furthermore, Hyatt, Arakawa, and Friend are likewise silent as to these features.

Insofar as references may be combined to teach a particular invention, and the proposed combination of Hyatt, Arakawa, and Friend in combination with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: “[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination.”

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicants' novel claimed invention. Furthermore, the claimed invention, as amended, meets the above-cited tests for obviousness by including embodiments such as “wherein the brightness of said display

screen is set to a plurality of levels and the refresh rate of said display screen is set to correspond to each level of the brightness of said display screen,” as recited in claims 1 and 15, and “wherein the luminance of said light source is set to a plurality of levels and the refresh rate of said display panel is set to correspond to each level of the luminance of said light source,” as recited in claim 5. As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Hyatt fail to disclose all of the elements of the claims of the present invention, particularly, the brightness of the display screen being set to a plurality of levels and the refresh rate of the display screen being set to correspond to each level of the brightness of the display screen, as discussed above, but also, if combined with Arakawa and Friend, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the

teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Hyatt, alone or in combination with Arakawa and Friend teaches an apparatus containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

Furthermore, as previously mentioned even if Hyatt were to be combined with Arakawa and Friend, it would still fail to teach the novel aspects of the invention. The invention provides a much more streamlined approach and a simpler concept than the proposed combination of Hyatt, Arakawa, and Friend. Therefore, the invention is different from either Hyatt, Arakawa, or Friend, whether alone or in combination with one another, and moreover, the invention is unobvious in light of the restrictive teachings of Hyatt, Arakawa, and Friend.

Claims 16-26 are added herein to further describe the invention and to further distinguish the invention from the cited prior art of record. Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added.

Therefore, Applicants respectfully submit that the cited prior art do not teach or suggest the features defined by amended independent claims 1, 5, and 14 and as such, claims 1, 5, and 14 are patentable over Palalau, Toffolo, or Hyatt alone or in combination with Arakawa and Friend. Further, dependent claims 2-3, 6, 8, and 16-26 are similarly patentable over Palalau, Toffolo, or Hyatt alone or in combination with Arakawa and Friend, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of

the invention they define. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

## II. Formal Matters and Conclusion

In view of the foregoing, Applicants submit that claims 1-3, 5-6, 8, 14, and 16-26, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

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